IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	Mikko LONNFORS *et al.*	Confirmation No.:	9543
Application No.:	10/804,600	Group Art Unit:	2442
Filed:	March 18, 2004	Examiner:	Blair, Douglas B

For: SYSTEM, APPARATUS AND METHOD FOR PROVIDING PARTIAL PRESENCE NOTIFICATIONS

Commissioner for Patents
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

This Appeal Brief is submitted in support of the Notice of Appeal dated June 29, 2010.

I. REAL PARTY IN INTEREST

Nokia is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF THE CLAIMS

Claims 1, 3 through 17, and 19 through 32 are pending in this application, in which claims 2 and 18 have previously been canceled, claims 1, 3 through 17, and 19 through 32 have been previously presented.

Claims 1, 3 through 8, 10 through 16 and 19 through 32 were finally rejected and claim 9 was finally objected in Office Action dated March 29, 2010. Claim 17 is allowed.

This Appeal is taken from the final rejection of claims 1, 3 through 8, 10 through 16 and 19 through 32 and final objection of claim 9 on March 29, 2010.

IV. STATUS OF AMENDMENTS

No Amendment has been filed subsequent to the issuance of the Final Office Action on March 29, 2010.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed invention is directed towards providing partial presence notifications relating to a presentity's presence information. In particular, by utilizing a presence document comprising a plurality of parameter relating to the presentity's presence information, partial presence information is communicated to subscribers.

Independent claim 1 recites:

1. A computer-readable storage medium having instructions stored thereon which are executable by a computer system by performing steps comprising (See, e.g. Specification ¶ [0081]):

creating a presence document corresponding to a presentity and specifying a version of the presence document, wherein the presence document comprises a plurality of parameters relating to the presentity, the parameters including the presence information (See, e.g. Specification ¶¶ [0034], [0055] through [0062]);

determining partial presence information as a portion of the presence information available for the presentity (See, e.g. Specification ¶¶ [0055], [0066] through [0068]); and

causing, at least in part, transmission of the presence document the partial presence information that has changed to a terminal requesting the presence information (See, e.g. Specification ¶¶ [0048], [0066], [0069], [0078]).

Dependent claim 7 recites:

7. The computer-readable storage medium of Claim 6, wherein a tuple version indicator corresponding to a new version of the tuple that has experienced the status information change is provided. (See, e.g. FIG. 4, Specification ¶ [0059]).

Independent claim 19 recites:

19. An apparatus, comprising:

a User Equipment (UE) terminal (See, e.g. Specification ¶ [0069]), comprising:

a processor (See, e.g. Specification ¶ [0070]);

a watcher application executable by the processor to generate at least one request for presence information of at least one presentity, to receive a presence document corresponding to the presentity and specifying a version of the presence document, wherein the presence document comprises a plurality of parameters relating to the presentity, the parameters including the presence information (See, e.g. Specification ¶¶ [0032], [0034], [0046], [0042], [0055] through [0065]); and

a memory to store the presence information, and to update one or more portions of the presence information identified by the partial presence information (See, e.g. Specification ¶¶ [0055], [0066], [0072]).

Independent claim 31 recites:

31. An apparatus, comprising:

a memory configured to store presence information related to one or more presentities (See, e.g. Specification ¶ [0072]);

a processor configured to generate a subscription request to subscribe to presence information of a target presentity (See, e.g. Specification ¶¶ [0034], [0071]);

a transceiver capable of transmitting the subscription request via a network, and capable of receiving a presence document corresponding to the presentity and specifying a version of the presence document, wherein the presence document comprises a plurality of parameters relating to the target presentity, the parameters including the presence information (See, e.g. Specification ¶¶ [0034], [0042], [0055] through [0065], [0074]); and

wherein the processor is further configured to direct the memory to update the presence information with the partial change information (See, e.g. Specification ¶¶ [0055], [0067], [0071]).

Independent claim 32 recites:

32. A system, comprising:

a presence server capable of being coupled to a plurality of terminals via a network for communicating presence information to one or more of the plurality of terminals, the presence server comprising (See, e.g. Specification ¶¶ [0031], [0032]):

a memory configured to store presence information for a plurality of presentities, and to store terminal subscriptions for terminals authorized to receive the presence information for one or more of the presentities (See, e.g. Specification ¶¶ [0045], [0078]);

a processing system coupled to the memory and configured to identify at least one presentity to which a particular terminal has subscribed, to create a presence document corresponding to the presentity and specifying a version of the presence document, wherein the presence document comprises a plurality of parameters relating to the presentity, the parameters including the presence information (See, e.g. Specification ¶¶ [0034], [0036], [0055] through [0062]); and

a data transmission module coupled to the processing system and capable of communicating the partial presence information via the presence document to the subscribing terminal, wherein the presence document includes the partial presence information for communicating a presence status to the subscribing terminal (See, e.g. Specification ¶¶ [0055], [0069], [0078]).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 3 through 8, 10 through 16, and 19 through 32 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon *Yoakum et al.* in view of *Davies et al.* further in view of *Birkler et al.*

Claim 9 was objected for being dependent upon a rejected base claim.

VII. ARGUMENT

A. CLAIMS 1, 3 THROUGH 8, 10 THROUGH 16, AND 19 THROUGH 32 ARE NOT OBVIOUS OVER *YOAKUM ET AL.* IN VIEW OF *DAVIES ET AL.* FURTHER IN VIEW OF *BIRKLER ET AL.* BECAUSE THE APPLIED REFERENCES FAIL TO DISCLOSE, AT LEAST, THE RECITED FEATURES, "CREATING A PRESENCE DOCUMENT CORRESPONDING TO A PRESENTITY AND SPECIFYING A VERSION OF THE PRESENCE DOCUMENT, WHEREIN THE PRESENCE DOCUMENT COMPRISES A PLURALITY OF PARAMETERS RELATING TO THE PRESENTITY, THE PARAMETERS INCLUDING THE PRESENCE INFORMATION" RECITED IN CLAIM 1, 19, 31 AND 32.

The Examiner bears initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision. *Gilbert & P. Hyatt v. Dudas*, 551 F.3d 1307, 1313 (Fed. Cir. 2008); *In re Glaug*, 283 F.3d 1335 (Fed. Cir. 2002*); In re Rijkaert,* 9 F.3d 1531, 1532 (Fed. Cir. 1992); *In re Oetiker,* 977 F.2d 1992*)*; *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984). *See, also, M.P.E.P. §2144 II.A*. In rejecting a claim under 35 U.S.C. §103(a), the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). Further, in rejecting a claim under 35 U.S.C. §103(a) it is incumbent upon the Examiner to establish the requisite motivation. As maintained by the Supreme Court of the United States in *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727 at 1741, an obviousness "analysis should be made explicit." See, *In re Kahn*, 441 F.3d 977, 988 (C.A. Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated

reasoning with some rational underpinning to support the legal conclusions of obviousness"). Indeed, the Examiner is required to make specific factual findings, not generalizations. *See M.P.E.P. §2144.08 II. A. 5*. That initial burden required by procedural **due process of law** has not been discharged.

As an initial matter, the Appellants note that the Examiner does not fully take into account the claim amendments presented in the Appellants' Office Action Response dated March 2, 2010. In the Response, Appellants have amended independent claims by adding at least, "a presence document corresponding to the presentity and **specifying of parameters relating to the presentity, the parameters including the presence information**" (Emphasis added). In spite of the amendments, the Examiner ignored the differences between original claims and amended claims and merely copied the reasons for rejection advanced for the original claims. Therefore, Appellants submits that the Examiner's initial burden has not been discharged. Further, there are substantial differences between the claimed method and system on the one hand and those of the applied references on the other hand that undermine the obviousness conclusion under 35 U.S.C. §103(a).

As stated previously, the Office Action does not present any reason for rejection regarding above recited claim features. The Examiner might have incorrectly assumed that "availability of a user from a plurality of devices" or "information provided by a user and derived from a plurality of sources" stated in *Yoakum et al*. (*see*, claim 1 and col. 3, lines 26-29 of *Yoakum et al.*) inherently describes the recited features, "**a plurality of parameters relating to the presentity**" (Emphasis added). Appellants note that there are fundamental differences between "availability of a user from a plurality of devices" or "information provided by a user and derived from a

plurality of sources" described in *Yoakum et al.* and "**a plurality of parameters relating to the presentity**."

Col. 3, lines 26-29 of *Yoakum et al.* merely states "a presence system capable of gathering state information provided by a user and derived from a plurality of sources associated with the user over any number of disparate networks." Gathering information from a plurality of sources does not inherently mean that "**presence document comprises a plurality of parameters relating to the presentity**." (Emphasis added). *Yoakum et al.* merely describes a presence system capable of monitoring state information derived from a plurality of sources over a number of disparate networks (Abstract). Based on the available state information, the presence system can provide different views of presence for different subscribers to allow the user to control delivery and use of presence information; and different subscribers may receive different presence information based on the same state information (col. 3, lines 51-56). However, *Yoakum et al.* is silent as to any **presence document** that comprises a **plurality of parameters** relating to **the presentity**. It is readily apparent and would have been understood by one having ordinary skill in the art that, as factual matter, *Yoakum et al.* merely describes a system capable of gathering availability information separately from more than one devices separately. By contrast, claim 1 recites "the presence document comprises a **plurality of parameters relating to the presentity**." (Emphasis added). For instance, Fig. 4 illustrates, as an embodiment, a single XML file comprising a plurality of parameters relating to the presentity information. Thus, *Yoakum et al.* clearly fails to expressly or inherently disclose any single presence document that comprises a plurality of parameters relating to the presentity. Based on the foregoing, it is apparent that *Yoakum et al.* neither discloses nor suggests the above recited claim features.

In addition, the other cited references do not cure the above mentioned deficiencies of *Yoakum et al*. Therefore, even if, for the sake of argument, the applied references are combined as proposed by the Examiner, and Appellants do not agree the requisite bases for the asserted motivation has been established, the invention defined in independent claim 1 would not result.

Accordingly, the subject matter of independent claims 1, 19, 31, and 32 is not obvious within the meaning of 35 U.S.C. § 103(a). Appellants, therefore submit that the imposed rejection of claims 1, 3 through 8, 10 through 16, and 19 through 32 under 35 U.S.C. § 103 is not factually or legally viable and, hence, solicits the Honorable Board to reverse the rejection.

B. CLAIMS 1, 3 THROUGH 8, AND 10 THROUGH 16 ARE NOT OBVIOUS OVER *YOAKUM ET AL.* IN VIEW OF *DAVIES ET AL.* FURTHER IN VIEW OF *BIRKLER ET AL.* BECAUSE THE APPLIED REFERENCES FAIL TO DISCLOSE, AT LEAST, THE RECITED FEATURES, "CAUSING, AT LEAST IN PART, TRANSMISSION OF THE PRESENCE DOCUMENT THE PARTIAL PRESENCE INFORMAITON THAT HAS CHANGED TO A TERMINAL REQUESTING THE PRESENCE INFORMATION" AS RECITED IN CLAIM 1.

In the statement of the rejection, the Office Action correctly admitted that *Yoakum et al*. do not disclose or suggest "transmitting presence information that has changed." (Office Action, p. 3, lines 15 and 16). In an attempt to remedy this deficiency, however, the Office Action asserts that "Davies teaches a method for only transmitting presence information that has changed (col. 17, lines 24-34)" (*see*, page 3, lines 17 and 18 of the Office Action). While the cited portion of *Davies et al.* discusses a situation when new information arrives, it merely states that "if some active subscriptions are present, the exposed presence manager 58 **consults the rules** 15 and determines what (if any) information to make available to the watching parties who have active subscriptions" (*see*, col.17, lines 29-33 of *Davies et al.*, emphasis added). In other words, instead of teaching the "partial presence information," which is determined as a portion of the presence

information available for the presentity, that is transmitted, *Davies et al.* merely teaches that making information available **based on just rules**. The rules 15 described in *Davies et al.* are simply rules stored in a rule base of presence management system 10 (*see*, Figure 3, col.14 lines 48 and 49 of *Davies et al.*). As an embodiment of the rules 15, *Davies et al.* states that "no instance messages should be accepted after 9 pm then the presence management system refuses the request" (*see*, col. 7 lines 32 and 33 of *Davies et al.*). Clearly, the stated rule is not for updating information based on partial presence information. The other recited references do not cure the above mentioned deficiencies.

Appellants, therefore submit that the imposed rejection of claim 1 and claims 3 through 8, and 10 through 16 dependent therefrom under 35 U.S.C. § 103 is not factually or legally viable and, hence, solicits the Honorable Board to reverse the rejection.

C. CLAIM 7 IS NOT OBVIOUS OVER *YOAKUM ET AL.* IN VIEW OF *DAVIES ET AL.* FURTHER IN VIEW OF *BIRKLER ET AL.* BECAUSE THE APPLIED REFERENCES FAIL TO DISCLOSE, AT LEAST, THE RECITED FEATURES, "VERSION OF THE TUPLE" AS RECITED IN CLAIM 7.

In the statement of rejection, the Office Action merely states that "[a]s to claims 6-8, see paragraph 20-23 of Birkler" (see, page 5 line 9 of the Office Action). Appellants respectfully disagree with the Examiner's conclusory statement.

Although the cited paragraphs of *Birkler et al.* teach a "presence information version number," it does not disclose "a **new version of the tuple**" as recited in claim 7.

Paragraphs [0020] through [0023] of *Birkler et al.* describe methods for updating data by comparing one type of version number, that is presence information version numbers. By contrast, claim 7 discloses "a version of the tuple" **in addition to** "a version of the presence

document" recited in independent claim 1 that claim 7 is originally depending from. *Birker et al.* does not disclose a tuple level version in addition to a presence information version number. Therefore, Appellants submit that *Birker et al.* fails to disclose "a tuple version indicator corresponding to a new version of the tuple that has experienced the status information change is provided." The deficiencies of *Birker et al.* are not cured by other applied references.

Appellants, therefore submit that the imposed rejection of claim 7 is under 35 U.S.C. §103 is not factually or legally viable in addition to the above advanced reasons and, hence, solicits the Honorable Board to reverse the rejection.

D. CLAIM 9 WAS OBJECTED TO FOR BEING DEPENDENT UPON A REJECTED BASE CLAIM

Claim 9 is dependent from claim 5, which is dependent from claim 1. As previously discussed, claim 1 is allowable based on the cited art. Therefore, the objection to claim 9 is improper and hence, Appellants respectfully solicit the Honorable Board to reverse to objection.

VIII. CONCLUSION AND PRAYER FOR RELIEF

For the foregoing reasons, Appellants request the Honorable Board to reverse each of the Examiner's rejections.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

September 29, 2010
Date

/Phouphanomketh Ditthavong/
Phouphanomketh Ditthavong
Attorney for Applicant(s)
Reg. No. 44658

Milin N. Patel
Attorney/Agent for Applicant(s)
Reg. No. 62768

918 Prince Street
Alexandria, VA 22314
Tel. (703) 519-9952
Fax (703) 519-9958

IX. CLAIMS APPENDIX

1. A computer-readable storage medium having instructions stored thereon which are executable by a computer system by performing steps comprising:

creating a presence document corresponding to a presentity and specifying a version of the presence document, wherein the presence document comprises a plurality of parameters relating to the presentity, the parameters including the presence information;

determining partial presence information as a portion of the presence information available for the presentity; and

causing, at least in part, transmission of the presence document the partial presence information that has changed to a terminal requesting the presence information.

2. (Canceled)

3. The computer-readable storage medium of Claim 1, wherein the presence information comprise a mode value indicative of whether the presence document includes the partial presence information or a complete update of the presence information.

4. The computer-readable storage medium of Claim 1, wherein the presence information comprise at least one action value.

5. The computer-readable storage medium of Claim 1, wherein the presence document conforms to a Common Profile for Instant Messaging (CPIM) specification using Presence Information Data Format (PIDF), and an extension to the CPIM PIDF presence document is created to facilitate determination of the partial presence information as a portion of the presence information available for the presentity.

6. The computer-readable storage medium of Claim 5, wherein the status information for one or more presence document tuples that have experienced a status information change is provided.

7. The computer-readable storage medium of Claim 6, wherein a tuple version indicator corresponding to a new version of the tuple that has experienced the status information change is provided.

8. The computer-readable storage medium of Claim 6, at least one action value is provided in the presence document tuples to identify an action to be taken at the terminal for the corresponding presence document tuples.

9. The computer-readable storage medium of Claim 5, wherein the version of the presence document is provided as a document version indicator, and the document version may be used by the terminal to determine whether presence information stored at the terminal is synchronized with a presence server.

10. The computer-readable storage medium of Claim 1, wherein the instructions executable by the computer system further comprise instructions for facilitating terminal subscription to the presence information of the at least one presentity.

11. The computer-readable storage medium of Claim 10, wherein the instructions executable by the computer system for facilitating terminal subscription to the presence information comprise instructions for facilitating at least one of terminal-initiated fetching and terminal-initiated polling for the presence information.

12. The computer-readable storage medium of Claim 11, wherein the instructions executable by the computer system for facilitating terminal subscription to the presence information

comprise instructions for subscribing the terminal to presence information notifications initiated at a presence server.

13. The computer-readable storage medium of Claim 12, wherein the instructions executable by the computer system for communicating the presence document comprise instructions for communicating the presence document when at least some of the presence information has changed.

14. The computer-readable storage medium of Claim 1, wherein the instructions executable by the computer system further comprise instructions for recognizing a change in at least some of the presence information, and wherein the instructions executable by the computer system for communicating the presence document comprise instructions for communicating the presence document in response to a presence information change.

15. The computer-readable storage medium of Claim 1, wherein the instructions executable by the computer system for communicating the presence document comprise instructions for communicating the presence document in response to at least one of an occurrence of a predetermined event, an occurrence of a predetermined time lapse, and a predetermined time.

16. The computer-readable storage medium of Claim 1, wherein the instructions executable by the computer system for configuring the presence information comprise instructions for providing at least one predefined attribute value with the partial presence information.

17. A computer-readable storage medium having instructions stored thereon which are executable by a computer system by performing steps comprising:

creating a presence document for use by at least one terminal requesting presence information regarding a presentity, comprising:

creating at least one tuple, wherein the tuple includes a version value indicating a version of the tuple relative to previous versions of the tuple;

associating presence information with the tuple, wherein the presence information comprises a subset of the presentity's complete set of presence information;

sending the presence document to the client terminal requesting the presence information;

comparing the version value provided via the tuple to a current version value stored on the client terminal; and

directing the client terminal to update presence information associated with the tuple, if the version value provided via the tuple indicates new presence information is available for that tuple.

18. (Canceled)

19. An apparatus, comprising:

a User Equipment (UE) terminal, comprising:

a processor;

a watcher application executable by the processor to generate at least one request for presence information of at least one presentity, to receive a presence document corresponding to the presentity and specifying a version of the presence document, wherein the presence document comprises a plurality of parameters relating to the presentity, the parameters including the presence information ; and

a memory to store the presence information, and to update one or more portions of the presence information identified by the partial presence information.

20. The apparatus as in Claim 19, wherein the watcher application is executable by the processor to generate the at least one request in the form of a subscription request to subscribe to the presence information of the at least one presentity.

21. The apparatus as in Claim 20, wherein the subscription request comprises a Session Initiation Protocol (SIP) SUBSCRIBE method.

22. The apparatus as in Claim 21, wherein the SUBSCRIBE method includes a Uniform Resource Identifier (URI) for the at least one presentity.

23. The apparatus as in Claim 19, wherein the watcher application is executable to receive the partial presence information by fetching the partial presence information.

24. The apparatus as in Claim 19, wherein the watcher application is executable by the processor to receive the partial presence information via a partial presence notification identifying the portion of the presence information available for the at least one presentity.

25. The apparatus as in Claim 19, wherein the watcher application is executable by the processor to receive the partial presence information in the form of a notification message to provide the watcher application with the partial presence information.

26. The apparatus as in Claim 25, wherein the notification message comprises a Session Initiation Protocol (SIP) NOTIFY method.

27. The apparatus as in Claim 19, further comprising a transceiver capable of transmitting the at least one request, and of receiving the partial presence information, via a network.

28. The apparatus as in Claim 19, wherein the UE terminal comprises a mobile terminal including a transmitter capable of wirelessly communicating the request for presence information, and including a receiver capable of wirelessly receiving the partial presence information, via a network.

29. The apparatus as in Claim 28, wherein the mobile terminal comprises a mobile phone.

30. The apparatus as in Claim 19, wherein the UE terminal comprises any of a Personal Digital Assistant, portable computing device, desktop computing device, workstation, or computer terminal.

31. An apparatus, comprising:

a memory configured to store presence information related to one or more presentities;

a processor configured to generate a subscription request to subscribe to presence information of a target presentity;

a transceiver capable of transmitting the subscription request via a network, and capable of receiving a presence document corresponding to the presentity and specifying a version of the presence document, wherein the presence document comprises a plurality of parameters relating to the target presentity, the parameters including the presence information; and

wherein the processor is further configured to direct the memory to update the presence information with the partial change information.

32. A system, comprising:

a presence server capable of being coupled to a plurality of terminals via a network for communicating presence information to one or more of the plurality of terminals, the presence server comprising:

a memory configured to store presence information for a plurality of presentities, and to store terminal subscriptions for terminals authorized to receive the presence information for one or more of the presentities;

a processing system coupled to the memory and configured to identify at least one presentity to which a particular terminal has subscribed, to create a presence document corresponding to the presentity and specifying a version of the presence document, wherein the presence document comprises a plurality of parameters relating to the presentity, the parameters including the presence information ; and

a data transmission module coupled to the processing system and capable of communicating the partial presence information via the presence document to the subscribing terminal, wherein the presence document includes the partial presence information for communicating a presence status to the subscribing terminal.

X. EVIDENCE APPENDIX

Appellants are unaware of any evidence that is required to be submitted in the present Evidence Appendix.

XI. RELATED PROCEEDINGS APPENDIX

Appellants are unaware of any related proceedings that are required to be submitted in the present Related Proceedings Appendix.